

Remarks

Claims 1 to 15 are in this application.

Reconsideration of the rejection of the claims is requested.

Acknowledgement is made that prosecution on the merits has been reopened after payment of the Issue fee on December 22, 2004 based upon references that were cited of record.

Claim 1

Claim 1 has been rejected as being anticipated by Brueker (of record). Issue is taken in this respect.

Brueker is directed to eyeglasses that are to be worn under a gas mask. As described, each lens 7, 17 is cut down as shown in Fig. 2 to give clearance under the gas mask and each is formed with a straight upper edge 8, an arcuate edge 9 and a straight edge 10. As noted by Brueker, a lens of this type can be ground without altering the prescription area of the lens and so that there is no change in the optical center of the lens. (See page 1, column 2, line 53 to page 2, column 1, line 17).

In addition, Brueker employs a conventional nose piece 13 (Fig. 3) that is located at the top of the lens 7, 17 and temple arms 15 that extend radially from the frames 12 downwardly and outwardly, and substantially at an acute angle to the horizontal. (Page 2, column 1, lines 53 to 57). By so locating the temple arms 15, they do not objectionably project beyond the peripheries of the frames 12 as to offer undesirable projections with which the gas mask may become engaged, causing a displacement of the spectacles (Page 2, column 1, lines 64 to 68).

The temples 14 of Brueker extend rearwardly from the frames and at the hinged ends are offset downwardly and inwardly at 18 to be disposed below the eyes in close proximity to the cheekbones under the eyes of the wearer as shown in Fig. 1. (Page 2, column 2, lines 1 to 6).

Claim 1 requires a temple to extend "in an upwardly angled direction from said frame". The temples 14 of Brueker are offset downwardly and inwardly at 18 in close proximity to the cheekbones. For this reason alone, Brueker is not readable on claim 1.

Claim 1 further requires a nose piece "for resting on a nose of a user with said lens supports spaced from the eyes of the user to permit access to the eyes of the user laterally of said frame for the application of makeup." Brueker does not describe or teach such a structure. Specifically, Brueker teaches that the eyeglasses are to be worn under a gasmask; that the temples 14 are to be located in close proximity to the cheekbones; and that the nose piece 13 is to be mounted on the bridge of a nose as illustrated in Fig.1. There is clearly no teaching that the eyeglasses of Brueker are constructed to permit the application of makeup to the eyes of the wearer particularly if the wearer is wearing a gas mask. For this additional reason, Brueker is not readable on claim 1.

Note is made of the Examiner's allegation that Brueker is capable of performing the intended use of "to permit access. . . for the application of makeup". However, the Examiner offers no evidence but only speculation as to this capability. The fact that Brueker teaches that the spectacles are to be worn *under a gas mask* with the lenses cut down to fit under the gas mask and the temples in close proximity to the cheekbones is evidence that the nose piece of Brueker is not positioned on the nose of

a user with the lens supports spaced from the eyes to permit access to the eyes laterally of the frame for the application of makeup. Also, the fact that the spectacles of Brueker are worn under a gas mask is further evidence that makeup cannot be applied to the eyes of a user. This would clearly be contrary to the teachings of Brueker.

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). (The Board reversed on the basis that the examiner did not provide objective evidence or cogent technical reasoning to support the conclusion of inherency.).

To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

In view of the above, a rejection of claim 1 as being anticipated by Brueker is not warranted pursuant to the provisions of 35 USC 102.

Claim 2

Claim 2 has been rejected as being unpatentable over Brueker (of record) in view of Knier (of record). Issue is taken in this respect.

Claim 2 depends from claim 1 and further requires each lens support to have a greater height than width thereof.

The Examiner alleges that Kneier discloses a pair of eyeglasses wherein each lens has a greater height than width thereof. Issue is taken in this respect. There is no description in Kneier as to the length and width of the lenses 24. Further, since the drawings are not drawn to scale, it is rank speculation to allege that the drawings contain a teaching of the relative width and height of a lens 24.

Furthermore, Brueker specifically teaches that each lens 7, 17 must be shaped in a particular manner without changing the optical center of the lens. Thus, making the lens 7 of Brueker of a greater height than width would be contrary to the teachings of Brueker.

For the above reasons, a rejection of claim 2 as being unpatentable over Brueker in view of Kneier is not warranted pursuant to the provisions of 35 USC 103.

Claim 5

Claim 5 has been rejected as being unpatentable over Brueker (of record) in view of Hirschman (newly cited). Issue is taken in this respect.

Claim 5 depends indirectly from claim 1 and further requires each mounting block for a temple to extend "laterally from said respective lens support". The Examiner alleges that it would be an obvious engineering choice to modify Brueker to have a temple arm 15 extend as claimed on the basis that such would not change the scope of the invention of Brueker. However, Brueker specifically teaches that the temple arm 15 is not to objectionably project beyond the periphery of the frame 12 as to offer undesirable projections with which the gasmask may become engaged. Thus, the proposed modification of Brueker would, in fact, change the scope of the invention of Brueker.

As noted in applicant's description in page 3, the mounting block 16 is mounted to extend laterally from the lens support 14 and is disposed to permit pivoting of a temple 12 about an axis that allows the temple 12 to fold parallel to the frame 11. Such is not possible in Brueker. Specifically, as can be seen in Figs. 3 and 4 of Brueker, the temple arms 15 extend radially downwardly (page 2, col. 1, lines 51-56) at an angle with the temples 14 hinged at 16. Since the temples 14 are hinged on the inclined axis 16, the temples 14 could not pivot into a flat condition behind the lens supports.

In view of the above, a rejection of claim 5 as being unpatentable over Brueker in view of Hirschman is not warranted pursuant to the provisions of 35 USC 103.

Claim 6

Claim 6 has been rejected as being unpatentable over Brueker (of record) in view of Hirschman (newly cited). Issue is taken in this respect.

Claim 6 depends from claim 1 and requires each temple to have "an angular section hingedly secured on a vertical axis".

The Examiner alleges that the hinged axis 16 of Brueker is vertical or nearly vertical. This is contrary to the illustration of Fig. 3 of Brueker and the teaching of Brueker that the temple arms 15 extend radially downwardly (page 2, col. 1, lines 51-56) at an angle with the temples 14 hinged at 16.

It is respectfully submitted that there is no teaching in Brueker of making the axis 16 vertical or nearly vertical since the axis 16 is horizontal in Fig. 3. Accordingly, the rejection of claim 6 as being unpatentable over Brueker in view of Hirschman is not warranted pursuant to the provisions of 35 USC 103.

Note also that claim 6 requires each temple to have "an angular section. . . , a rectilinear section. . . and an adjustable curved end piece. . .". The temple 14 of Brueker does not have three such sections. For this additional reason, a rejection of claim 6 is not warranted pursuant to the provisions of 35 USC 103.

Claim 8

Claim 8 has been rejected as being unpatentable over Brueker (of record) in view of Hirschman (newly cited). Issue is taken in this respect.

Claim 8 depends indirectly from claim 6 and requires each mounting block to extend "laterally from said respective lens support". The temple arms 15 of Brueker extend radially downwardly (page 2, col. 1, lines 51-56) at an angle not laterally.

As indicated in applicant's Fig. 2, and as described above, the mounting block allows the temples to fold flat against the lens supports. Such is not possible in Brueker.

Accordingly, a rejection of claim 9 as being unpatentable over Brueker in view of Hirschman is not warranted pursuant to the provisions of 35 USC 103.

Claim 9

Claim 9 has been rejected as being unpatentable over Brueker (of record) in view of Hirschman (newly cited). Issue is taken in this respect.

Claim 9 depends indirectly from claim 6 and requires each mounting block to extend "transversely from said respective lens support". The temple arms 15 of Brueker extend radially downwardly (page 2, col. 1, lines 51-56) at an angle not transversely.

As indicated in applicant's Fig. 2, and as described above, the mounting block allows the temples to fold flat against the lens supports. Such is not possible in Brueker.

Accordingly, a rejection of claim 9 as being unpatentable over Brueker in view of Hirschman is not warranted pursuant to the provisions of 35 USC 103.

Claims 3, 4 and 7

Claims 3, 4 and 7 depend directly or indirectly from claim 1 and are believed to be allowable for similar reasons.

Claims 10 and 11

Claims 10 and 11 contain recitations similar to claims 1 and 2 and are believed to be allowable for similar reasons.

New claim 12 is directed to an eyeglass construction for applying makeup about the eyes of the wearer. Clearly, Brueker is not directed to such a structure. Instead, Brueker is directed to an eyeglass frame for fitting under a gasmask and close to the face of the wearer.

Claim 12 (new)

Claim 12 is directed to an eyeglass construction for applying make-up about the eyes of a wearer. Brueker is directed to a non-analogous structure.

Claim 12 also requires a pair of temples to rest on the ears of a wearer "with said pair of lens supports spaced away from the face of the wearer to allow a makeup applicator to be inserted between said frame and the eyes of the wearer". None of the references of record describes or teaches such a structure. In particular, Brueker is void of any such teaching.

Claim 12 further requires a nosepiece on the frame "for resting on a *distal end* of a nose of a user with said lens supports spaced from the eyes of the user to permit access. . . for the application of makeup". As can be seen in Fig. 1 of Brueker, the eyeglass is mounted on the bridge of the nose and not on a distal end of the nose of the wearer. Further, mounting of the nosepiece 13 at a distal end of the nose would space the lenses and frame away from the face of the user and would interfere with the mounting of the gas mask over the face of the person. This would be contrary to the teachings of Brueker.

In view of the above, claim 12 is believed to be allowable over the references of record pursuant to the provisions of 35 USC 102 and 103.

Claims 13 to 15 (new)

Claims 13 to 15 depend from claim 12 and are believed to be allowable for similar reasons.

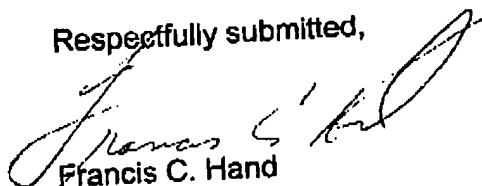
Claim 13 further recites that the nose piece "is disposed near a lower end of said lens supports". As can be seen in Fig. 3 of Brueker, the nose piece 13 is located at the upper ends of the lens supports. Accordingly, claim 13 is believed to be further allowable over the references of record pursuant to the provisions of 35 USC 102 and 103.

Claim 14 depends from claim 13 and further requires "a reinforcing bar integral width and extending between said lens supports. . . above said nose piece.". None of the references of record describes or teaches such a structure. Accordingly, claim 14 is believed to be further allowable over the references of record pursuant to the provisions of 35 USC 102 and 103.

Claim 15 contains recitations similar to claim 6 and is believed to be allowable for similar reasons as expressed above.

The application is believed to be in condition for allowance and such is respectfully requested.

Respectfully submitted,



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